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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/432,668	11/02/1999	YONATAN SILVER	U 013173-8	1351
140	7590	10/06/2003	EXAMINER	
LADAS & PARRY 26 WEST 61ST STREET NEW YORK, NY 10023			SMITHERS, MATTHEW	
			ART UNIT	PAPER NUMBER
			2134	
DATE MAILED: 10/06/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/432,668	SILVER, YONATAN
	<b>Examiner</b>	<b>Art Unit</b>
	Matthew B Smithers	2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 02 November 1999.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-32 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-4,7,9,11-15,17,21-27,31 and 32 is/are rejected.
- 7) Claim(s) 5,6,8,10,16,18-20 and 28-30 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
 

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ .
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .	6) <input type="checkbox"/> Other: _____ .

## **DETAILED ACTION**

### ***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Information Disclosure Statement***

The information disclosure statements filed March 27, 2000, December 27, 2000, April 26, 2001, May 11, 2001, September 13, 2002 and January 17, 2003 have been placed in the application file and the information referred to therein has been considered as to the merits.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 7, 9, 11-15, 17, 21-27, 31 and 32 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. patent 6,020,882 granted to Kinghorn et al.

Regarding claim 1, Kinghorn meets the claimed limitation as follows:

"An access control method for use with a broadcast communication network, the method comprising:

receiving an encoded program at a subscriber unit via the broadcast communication network; and

preventing decoding of the encoded program at the subscriber unit for at least one preselected time period, preselected in accordance with a preference of a user of the subscriber unit." see abstract; column 6, lines 1-20; column 8, line 63 to column 9, line 23 and column 10, line 60 to column 11, line 12.

Regarding claim 2, Kinghorn meets the claimed limitation as follows:  
"A method according to claim 1 and wherein said step of preventing decoding comprises the step of disabling display of the program in a clear form at the subscriber unit for said at least one preselected time period in response to a selection inputted by the user." see column 6, lines 37-40; column 7, lines 29-40 and column 8, lines 63-64.

Regarding claim 3, Kinghorn meets the claimed limitation as follows:  
"A method according to claim 1 and wherein said step of preventing decoding comprises the step of disabling display of the program in a clear form at the subscriber unit for said at least one preselected time period in response to disabling data inputted at a headend of the broadcast communication network." see column 6, lines 3-9; column 6, lines 21-35; and column 6, lines 61-64.

Regarding claim 4, Kinghorn meets the claimed limitation as follows:

"A method according to claim 3 and wherein said disabling data comprises addressed restriction information which is individually addressed to the subscriber unit." see column 9, lines 35-40.

Regarding claim 7, Kinghorn meets the claimed limitation as follows:

"A method according to claim 3 and wherein said disabling data comprises at least a portion of characteristics of the at least one preselected time period." see column 8, lines 63-67.

Regarding claim 9, Kinghorn meets the claimed limitation as follows:

"A method according to claim 7 and wherein said characteristics of the at least one preselected time period comprise at least one of the following: a beginning time of the at least one preselected time period and an ending time of the at least one preselected time period; and a beginning time of the at least one preselected time period and a length of the at least one preselected time period." see column 10, line 60 to column 11, line 12 and Figure 7.

Regarding claim 11, Kinghorn meets the claimed limitation as follows:

"A method according to claim 1 and wherein said step of preventing decoding comprises the step of disabling display of a program in a clear form at a channel to which the subscriber unit is tuned during said at least one preselected time period." see column 8, lines 7-36 and column 9, lines 9-14.

Regarding claim 12, Kinghorn meets the claimed limitation as follows:

"A method according to claim 1 and wherein said step of preventing decoding comprises the step of disabling display of a pay program in a clear form at a channel to

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which the subscriber unit is tuned during said at least one preselected time period." see column 8, lines 7-36 and column 9, lines 9-14.

Regarding claim 13, Kinghorn meets the claimed limitation as follows:

"A method according to claim 1 and wherein said program comprises at least one of the following: a television program; a pay television program; a commercial; a video clip; a program guide; an electronic program guide (EPG); data; multimedia information; a hypermedia link; a computer program; computer data; an application which may be downloaded; a program applet; teletext information; an audio program; a textual information program; an image generating program; electronic-mail; and voice mail." see column 6, lines 1-20; column 8, lines 7-36 and column 9, lines 9-14.

Regarding claim 14, Kinghorn meets the claimed limitation as follows:

"A method according to claim 1 and wherein said at least one preselected time period comprises at least one of the following: a periodic time period; and a specific time period." see column 10, line 60 to column 11, line 12 and Figure 7.

Regarding claim 15, Kinghorn meets the claimed limitation as follows:

"A method according to claim 2 and wherein said step of preventing decoding comprises the steps of:

generating a disabling code in response to said selection inputted by the user; and employing said disabling code to prevent decoding of said program for said at least one preselected time period." see column 6, lines 37-40; column 6, lines 49-52; column 7, lines 29-40 and column 8, lines 63-64.

Regarding claim 17, Kinghorn meets the claimed limitation as follows:

"A method according to claim 3 and wherein said step of preventing decoding comprises the steps of:

transmitting the program associated with an individually addressed disabling code from the headend; receiving the program with the associated individually addressed disabling code at the subscriber unit; separating the individually addressed disabling code from the program to produce a separated individually addressed disabling code; processing the separated individually addressed disabling code to determine whether the individually addressed disabling code is addressed to the subscriber unit; and preventing decoding of said program for said at least one preselected time period if said individually addressed disabling code is addressed to the subscriber unit." see column 6, lines 3-9; column 6, lines 21-35; column 6, lines 61-64 and column 9, lines 21-40.

Regarding claim 21, Kinghorn meets the claimed limitation as follows:

"A method according to claim 1 and wherein said at least one preselected time period is selected to immediately follow an additional time period during which programs broadcast via the broadcast communication network are displayed in a clear form." see column 10, line 60 to column 11, line12.

Regarding claim 22, Kinghorn meets the claimed limitation as follows:

"An access control method for use with a broadcast communication network, the method comprising:

receiving an encoded program at a subscriber unit via the broadcast communication network;

and enabling decoding of the encoded program at the subscriber unit for at least one preselected time period, preselected in accordance with a preference of a user of the subscriber unit." see abstract; column 6, lines 1-20; column 8, line 63 to column 9, line 23 and column 10, line 60 to column 11, line 12.

Regarding claim 23, Kinghorn meets the claimed limitation as follows:  
"Apparatus at a subscriber unit for providing access control to broadcast transmissions, the apparatus comprising: a receiver and decoder unit operative to receive and decode a program broadcast via a broadcast communication network in an encoded form; and a processor operatively associated with the receiver and decoder unit and operative to disable decoding of the program at the receiver and decoder unit for at least one preselected time period, preselected in accordance with a preference of a user of the subscriber unit." see column 6, lines 33-40 and column 8, lines 7-36.

Regarding claim 24, Kinghorn meets the claimed limitation as follows:  
"Apparatus according to claim 23 and also comprising a user input device operatively associated with said processor and operative to enable input of data determining said at least one preselected time period." see column 6, lines 49-51.

Regarding claim 25, Kinghorn meets the claimed limitation as follows:  
"Apparatus according to claim 24 and wherein said user input device comprises at least one of the following: a keypad; a remote control unit; and a mouse pointer." see column 6, lines 49-51.

Regarding claim 26, Kinghorn meets the claimed limitation as follows:

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"Apparatus according to claim 24 and also comprising a memory for storing data determining said at least one preselected time period." see column 8, lines 61-67.

Regarding claim 27, Kinghorn meets the claimed limitation as follows:

"Apparatus according to claim 23 and wherein said receiver and decoder unit is also operative to receive the program with a disabling code associated therewith, to separate the disabling code from the program, and to provide the disabling code to the processor, and said processor is also operative to determine whether the disabling code is addressed to the subscriber unit, and to prevent decoding of the program for said at least one preselected time period if the disabling code is addressed to the subscriber unit." see column 9, lines 35-40.

Claim 31 is an apparatus claim that is substantially equivalent to method claim 1.

Therefore claim 31 is rejected by a similar rationale.

Claim 32 is an apparatus claim that is substantially equivalent to method claim 22.

Therefore claim 32 is rejected by a similar rationale.

### ***Allowable Subject Matter***

Claims 5, 6, 8, 10, 16, 18-20, and 28-30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

With respect to claims 5, 6, 8, 10, 19 and 28-30, the cited prior art fails to specifically teach wherein said step of preventing decoding comprises the step of

disabling display of the program in a clear form at the subscriber unit for said at least one preselected time period in response to disabling data resident in a removable security element which is operatively associated with said subscriber unit wherein said disabling data resident in the removable security element is stored in the removable security element before the removable security element is provided to the user for use thereby.

With respect to claims 16 and 18, the cited prior art fails to specifically teach wherein said disabling code is associated with a payment code determining a payment rate.

With respect to claim 20, the cited prior art fails to specifically teach wherein said disabling code is comprised in one of the following: an Entitlement Control Message (ECM); and an Entitlement Management Message (EMM).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- A. Yamamoto (6,360,367) discloses a device for inhibiting a subscriber from viewing a broadcasted program.
- B. Miyakoshi (6,481,009) discloses a device for regulating viewing of a program.
- C. Grant et al (6,553,566) discloses a method for a viewer to control processing of received television signals.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew B Smithers whose telephone number is (703) 308-9293. The examiner can normally be reached on Monday-Friday (9:00-5:30) EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory A Morse can be reached on (703) 308-4789. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

*Matthew B. Smithers*  
Matthew B Smithers  
Primary Examiner  
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